

REMARKS

Claims 1-32 are presented for examination. Claims 30-31 have been cancelled without prejudice or disclaimer. New claims 33-36 have been added.

In response to drawing corrections required by the PTO-948 form, formal drawings are submitted herewith.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-9, 12, 13, 15, 17-32 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Tracy (U.S. Patent No. 5,979,757). The Examiner's rejection is respectfully traversed for the following reasons.

Anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied*, 110 S.Ct. 154 (1989). The term "anticipation," in the sense of 35 U.S.C. 102, has acquired the accepted definition meaning "the disclosure in the prior art of a thing substantially identical with the claimed invention." *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978). The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). To satisfy this burden, therefore, each and every element of the claimed invention must be shown by the Examiner to be disclosed in Tracy. However, as demonstrated below, Tracy does not disclose some of the claimed elements.

CLAIMS 1-9, 12, 13, 15, 17-20

Claim 1 has been amended to include the subject matter of claim 6 and more clearly define the claimed invention. Claim 1, as amended, recites a retail system comprising:

- at least one purchase ordering facility for providing representations of items offered for sale,
- at least one portable device movable by a customer for detecting indicia of said representations to select the items to be included in a purchase order, and
- a purchase ordering terminal provided in the purchase ordering facility for enabling a customer to order products available for sale in the retail system including the items that are not represented in the purchase ordering facility.

The Examiner relies upon FIG. 7C of Tracy for disclosing the claimed purchase ordering terminal.

Considering the reference, FIG. 7C of Tracy shows the use of a comparison function by a portable terminal. The terminal displays an identification of the item scanned and its cost. In addition, it displays alternative brands and their cost (col. 10, line 63 to col. 11, line 3).

Accordingly, the reference does not suggest displaying items that are not represented in the purchase ordering facility.

Further, the Examiner relies upon col. 2, lines 12-29 of Tracy for disclosing the purchase ordering facility. However, this portion of the reference discloses a self-scanning application of a hand-held terminal and does not suggest that the scanned products are being ordered rather than purchased. To more clearly define the claimed invention, claim 1 has been amended to specifically indicate that the purchase ordering terminal for enabling a customer to order products is provided in the purchase ordering facility.

Applicant respectfully submits that Tracy does not teach or suggest providing a purchase ordering terminal in a purchase ordering facility to enable a customer to order products available for sale in the retail system including the items that are not represented in the purchase ordering facility, as claim 1 requires.

Claims 2-20 dependent from claim 1 are defined over the reference at least for the reasons presented above in connection with claim 1. Further, the reference does not disclose the subject matter of some of the dependent claims. For example, claims 7 and 8 dependent from claim 1 recite that the purchase ordering terminal is configured:

- to enable the customer to continue placing the product order after selecting the items using the portable device, and
- to read purchase order information from the portable device.

The Examiner relies upon col. 6, lines 27-51 and col. 6, lines 44-51 of Tracy for disclosing these features. However, these portions of the reference disclose a retail facility including point-of-sale terminals 170 “used to receive payment from customers after they have selected items for purchase and to process customers not using portable terminals to collect items for purchase.”

Hence, the reference does not disclose that the point-of-sale terminal 170 is a purchase ordering terminal enabling a customer to continue placing the product order. Also, Tracy does not teach that the terminal 170 reads purchase order information from the portable terminal.

Dependent claim 9 recites that the purchase ordering terminal is configured to present an electronic catalog including the products available for sale in the retail system.

The Examiner relies upon FIGS. 7A-D for disclosing this feature. However, these figures shows a screen of the portable terminal displaying information relating to items scanned by a

customer during a shopping procedure. The reference does not suggest presenting an electronic catalog including the products available for sale in the retail system.

Moreover, the reference does not suggest that the portable terminal is a purchase ordering terminal enabling a customer to order products available for sale in the retail system including the items that are not represented in the purchase ordering facility.

With respect to dependent claim 10, the Examiner states that Tracy teaches the purchase ordering terminal configured to electronically simulate an Internet site, and relies upon col. 2, lines 41-56.

First, this subject matter is recited in claim 12 rather than in claim 10. Moreover, col. 2, lines 41-56 of Tracy discloses machine readable labels having URLs “used to reference sites on the world wide web.” However, Tracy does not disclose a purchase ordering terminal configured to electronically simulate an Internet site.

Dependent claim 15 recites that the purchase order is automatically transferred to a central station when the portable device reads the indicia of the output device. The Examiner relies upon col. 3, lines 38-48 for disclosing this subject matter.

This portion of the reference discloses a wireless network for “communicating data to a central computer.” However, Tracy does not suggest automatically transferring a purchase order to a central station when the portable device reads the indicia of the output device.

Dependent claim 17 recites that the output representing the purchase order controls a passing device that allows the customer to leave the purchase ordering facility. The Examiner relies upon FIG. 9, item 190.

However, the reference does not disclose that the check-out station 190 in FIG. 9 produces the output representing the purchase order to control a passing device that allows the

customer to leave the purchase ordering facility.

Dependent claim 19 recites that a purchase ordered at the purchase ordering facility may be picked up at a retail facility remote from the purchase ordering facility. The Examiner relies upon FIG. 10 for disclosing this feature.

However, FIG. 10 illustrates an embodiment, in which a customer uses his PC at home for selecting items to be included in a shopping list for the next shopping or for delivery. The reference does not suggest that a purchase ordered at the purchase ordering facility (that provides representations of items offered for sale) may be picked up at a retail facility remote from the purchase ordering facility.

Also, the reference does not disclose the purchase ordering terminal configured to display a plurality of available retail facilities to enable a customer to select a retail facility, to which the ordered purchase should be delivered, as dependent claim 20 requires.

CLAIMS 21-24

Independent claim 21, as amended to clarify the claimed language, recites a retail system having multiple purchase ordering facilities for placing purchase orders, at least one of the retail facilities provides representation of a limited number of items offered for sale, said at least one of the retail facilities is provided with at least one purchase ordering terminal for enabling the customer to order all products available in the retail system including products not represented by the limited number of items offered for sale.

As discussed above, Tracy does not disclose the claimed purchase ordering terminal.

Dependent claim 22 (as well as dependent claim 6) have been amended to recite that the purchase ordering terminal is provided with a purchase mode selection circuit for enabling the

customer to select a desired purchase ordering mode defining electronic simulation performed by the purchase ordering terminal.

Dependent claims 23 and 24 respectively recite that the purchase ordering terminal is configured to electronically simulate a game and an Internet site. Tracy does not disclose these features.

CLAIMS 25 AND 26

Independent claim 25, as amended to clarify the claimed language, recites a retail system comprising:

- a plurality of purchase ordering facilities provided in retail facilities for enabling customers to place purchase orders, and
- a plurality of purchase check-out facilities provided in the retail facilities for enabling the customers to receive ordered purchases.

The claim specifies that a purchase ordering facility of said plurality of purchase ordering facilities includes a purchase ordering terminal for enabling a customer to place an order for a purchase. The purchase ordering terminal is configured for displaying a list of the retail facilities to enable the a customer to receive the ordered purchase at a purchase check-out facility of said plurality of purchase check-out facilities remote with respect to the purchase ordering facility where the purchase was ordered.

Dependent claim 26 recites that the purchase ordering facility contains samples of items offered for sale, and said purchase ordering terminal is configured for enabling the customer to order products available for sale in the retail system including the items that are not represented in the purchase ordering facility.

As discussed above, Tracy does not disclose the subject matter of claims 25 and 26.

CLAIMS 27-29, 33-37

Independent claim 27, as amended to clarify the claimed language, recites a retail system controlled by a control system and comprising:

- at least one storage facility for storing goods available for sale in the retail system, and
- multiple retail facilities remote with respect to the storage facility.

A retail facility includes a purchase ordering facility having at least one purchase ordering terminal for enabling a customer to order a purchase and a purchase obtaining point for enabling the customer to obtain the purchase ordered at the purchase ordering facility after a time period sufficient to deliver the ordered purchase from the storage facility to the purchase obtaining point.

The Examiner relies upon FIG. 10 for disclosing a purchase obtaining point for enabling the customer to obtain the ordered purchase after a time period sufficient to deliver the ordered purchase from the storage facility to the purchase obtaining point.

As discussed above, FIG. 10 illustrates an embodiment, in which a customer uses its PC at home for selecting items to be included in a shopping list for the next shopping, or for delivery. The reference does not suggest obtaining the purchase ordered at the purchase ordering facility having a purchase ordering terminal after a time period sufficient to deliver the ordered purchase from the storage facility to the purchase obtaining point.

Claims 28 and 29 specify that the retail facility contains samples of a limited number of items offered for sale, and the purchase ordering terminal is configured for enabling the customer to order products available for sale in the retail system, including the items that are not represented by the samples.

As discussed above, Tracy does not disclose this subject matter.

Newly added claims 33-36 dependent from claim 27 recite the subject matter similar to the subject matter of the claims 6, 11, 12 and 17 discussed above.

CLAIM 32

Claim 32 has been rewritten in independent form including limitations of claims 30 and 31. This claim recites a method of selling goods comprising the steps of:

- storing goods available for sale in a storage facility,
- presenting samples of the goods at a purchase ordering facility to enable a customer to order a purchase, the purchase ordering facility presenting samples of a limited number of items offered for sale,
- enabling the customer to obtain the ordered purchase at a purchase obtaining point after a time period sufficient to deliver the purchase from the storage facility to the purchase obtaining point, and
- providing a purchase ordering terminal in the purchase ordering facility for enabling the customer to order products available for sale, including the items that are not represented by the samples.

The Examiner relied upon FIG. 7C for disclosing this subject matter. However, as discussed above, FIG. 7C of Tracy shows the use of a comparison function by a portable terminal. The terminal displays an identification of the item scanned and its cost. In addition, it displays alternative brands and their cost (col. 10, line 63 to col. 11, line 3).

Hence, the reference does not teach or suggest providing a purchase ordering terminal in the purchase ordering facility for enabling the customer to order products available for sale,

including the items that are not represented by the samples at the purchase ordering facility, as claim 32 requires.

Accordingly, the claimed invention is not anticipated by Tracy within the meaning of 35 U.S.C. § 102.

REJECTION UNDER 35 U.S.C. § 103

Claims 10, 11, 14 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tracy in view of Official Notice.

The Examiner admits that Tracy does not disclose the subject matter of these claims. However, he takes the position that this subject matter was old and well known in the art at the time of invention.

The Examiner's position is respectfully traversed. The Applicant respectfully submits that the prior art does not teach or suggest the claimed purchase ordering terminal provided in the purchase ordering facility for enabling a customer to order products available for sale in the retail system including the items that are not represented in the purchase ordering facility, and configured to electronically simulate:

- a store containing the products available in the retail system, and
- a game, as claims 10 and 11 require.

Also, the prior art does not teach or suggest the output device provided with indicia readable by the portable device to automatically produce the output representing the purchase order formed by the portable device, as claims 14 and 16 require.

In accordance with MPEP 2144.03, the Examiner is respectfully requested to cite a reference in support of his position.

In view of the foregoing, and in summary, claims 1-29, and 32-36 are considered to be in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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